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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,114	11/21/2003	Teck Chia	14326US02	1805
23446 7590 05/28/2008 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			EXAMINER ALMATRAHI, FARIS S	
			ART UNIT 3627	PAPER NUMBER
			MAIL DATE 05/28/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/719,114

Applicant(s)

CHIA ET AL.

Examiner

FARIS ALMATRAHI

Art Unit

3627

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-23 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 12-23 and 26-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date 03/22/2004, 10/15/2004, 04/28/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

1. This action is in reply to applicant amendment filed March 11, 2008.
2. Claims 12 and 16 are amended.
3. Claims 1-11 and 24-25 are cancelled.
4. Claims 26-34 are new.
5. Claims 12-23 and 26-34 are pending in this application

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-15 and 26-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A single claim which claims both a system and the method steps is rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101. Claim 12 is directed to a method and overlaps disclosure of a system "wherein the system comprises the electronic device and a network".

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 12-15, 22-23, and 26-31** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. **Claim 12** recites the limitation "wherein the system comprises the electronic device and a network". The claim is viewed as vague and indefinite because the claim is directed to neither a "process" nor a "machine", but rather embraces or overlaps two different statutory classes. Claim 12 also recites the limitation "managing the lifecycle of the updating information by enabling and disabling distribution of the updating information according to a state in the lifecycle of the updating information". There is insufficient antecedent basis for the phrase "the lifecycle" in the claim. It is unclear as to what the applicant is referring to.

10.

11. **Claim 22** recites the limitation "wherein the electronic devices maintain statistics information regarding the total number of distributed updating information and the time of distribution of the updating information and communicate the statistics information to a server". There is insufficient antecedent basis for the phrase "the total number" and "the time". It is unclear as to what the applicant is referring to.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. **Claims 12-23, and 26-34** are rejected under 35 U.S.C. 102(e) as being anticipated by Thurston et al. (US Publication No. 2003/0217193 A1).

14. Regarding claims 12 and 16-17, Thurston discloses a system and method for updating firmware in an electronic device of a system, wherein the system comprises the electronic device and a network, the method comprising: generating updating information for updating the firmware to a particular version of the firmware, in a generation environment (Abstract, Figure 3, Paragraphs [0008] – [0009]); saving the generated updating information in a storage (Paragraph [0024]); communicating the saved updating information to a distribution environment comprising a network that distributes the updating information to one or more electronic devices (Abstract, Figure 1); and managing the lifecycle of the updating information by enabling and disabling distribution of the updating information according to a state in the lifecycle of the updating information (Figure 7, Paragraphs [0052] – [0053]).

15. Regarding claim 13, Thurston discloses a method further comprising packaging the saved updating information before communicating it to the distribution environment (Figure 3).
16. Regarding claim 14, Thurston discloses a method wherein the distribution environment comprises an updating storage and a server (Abstract, Figure 1).
17. Regarding claim 15, Thurston discloses a method further comprising receiving requests for updating information (Figure 7); facilitating downloads of the requested updating information (Figure 7); verifying reception of the downloaded updating information (Figure 7); and utilizing the downloaded updating information to update firmware in the electronic device (Figure 7).
18. Regarding claim 18, Thurston discloses a system wherein lifecycle management comprises at least one of: facilitating loading of the updating information; facilitating deleting of the updating information; and facilitating editing of status information of the updating information (Figure 7, Paragraph [0032]).
19. Regarding claims 19-20, Thurston discloses a system wherein the network further comprises a lifecycle management component that manages the lifecycle of the electronic devices (Figure 3).
20. Regarding claims 21 and 34, Thurston discloses a system wherein lifecycle management comprises at least one of: provisioning of the electronic devices; determining change of ownership of the electronic devices; determining change of subscription of the electronic devices; and determining when an electronic device is no longer in use in the system (Figure 8).

21. Regarding claims 22-23, Thurston discloses a system wherein the electronic devices maintain statistics information regarding the total number of distributed updating information and the time of distribution of the updating information and communicate the statistics information to a server (Paragraphs [0040] –[0041]).
22. Regarding claim 26, Thurston discloses a method wherein the lifecycle management system causes a change in the lifecycle state of updating information stored in a network that communicated the updating information to the one or more electronic devices (Figure 7, Paragraphs [0052] – [0053]).
23. Regarding claim 27, Thurston discloses a method wherein a particular level of system operator authority is required to change the lifecycle state of the stored updating information and to specify a time when the change of the lifecycle state of the stored updating information is to occur (Paragraph [0058]).
24. Regarding claims 28-29, Thurston discloses a method further comprising updating state information for the particular version of updating information in a database of lifecycle information for update information (Figure 8).
25. Regarding claims 30 and 33, Thurston discloses a system and method wherein lifecycle management of updating information comprises one or more of creating updating information, deleting updating information, editing updating information, changing state information for updating information, specifying recipients of distributed updating information, or specifying a time to begin distributing update information (Figures 8-10, Paragraph [0037]).

26. Regarding claims 31 and 32, Thurston discloses a system and method wherein updating information comprises and update package (Figure 4).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faris Almatrahi whose telephone number is (571) 270-3326. The examiner can normally be reached on Monday to Friday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627

/Faris Almatrahi/
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FA

